

REMARKS

I. Introduction

Claims 1–15 are pending in the application. In view of the following remarks, Applicants respectfully request reconsideration of the pending rejections and submit that all pending claims are in condition for allowance.

No new matter has been introduced by amendments to the claims. The amendment to claim 10 is supported by the specification at page 32, lines 24-25. The amendments to claims 3 and 6 are supported by the specification at page 16, second line from the bottom, to page 17, line 10. The amendments to claims 4 and 7 are supported by the specification at page 20, line 6 to page 21, line 2. The amendments to claim 10 are supported by the original claims 3 and 13, and by the specification at page 16, second line from the bottom to page 17, line 10, and also supported by the specification at page 20, line 6 to page 21 line 16.

II. Claim Rejections Under 35 U.S.C. § 101

Claims 1 – 9 have been rejected under 35 U.S.C. § 101 because the claimed invention is allegedly not supported by either a specific and substantial asserted utility or a well established utility. The Applicant respectfully submits that, at a minimum, measuring blood sugar concentration for diabetic patients and using the results to determine a quantity of insulin for injection is a well established utility for blood sugar concentration. Measuring blood sugar concentration is disclosed in the first paragraph of the specification.

However, in the interests of compact prosecution, claim 1 has been amended to more clearly and explicitly recite a useful, concrete and tangible result by inserting the term “outputting the concentration of the specific component.”

Thus, independent claim 1 and dependent claims 2-9 are useful under 35 U.S.C. § 101.

Claim 10 has been rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter because it improperly includes body parts as part of the invention. Claim 10 has been amended to clarify that body parts are not part of the invention, and now recites “an optical element adapted to be brought into contact with a living body.”

Thus, claim 10 is statutory subject matter under 35 U.S.C. § 101.

III. Claim Rejections Under 35 U.S.C. § 102 (Robinson)

Claims 1, 8, 10-12 and 14 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,152,876 (Robinson et al).

Independent claim 1 recites, in part, “detecting the light . . . obtaining a wavenumber signal . . . correcting said wave number signal with the use of a calibration line.”

Independent claim 10 recites, in part, “a signal processing means for processing a wavenumber signal obtained in said light detecting means to correct said wavenumber signal with the use of one or more calibration line(s).”

Anticipation under 35 U.S.C. § 102(b) requires that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed Cir. 1987).

Robinson does not disclose the recited elements of claims 1 and 10. Robinson merely discloses preventing errors by leveling tissue height **before** a wavenumber signal is obtained, stating “[t]his can insure a reproducible, consistent height is achieved **before** commencing the

spectral measurement of the tissue” at col. 14, lines 49-51. Emphasis added. In other words, Robinson corrects the height, and does not correct the wavenumber signal.

In contrast to Robinson, claims 1 and 10 employ a calibration line to correct errors **after** the wavenumber signal is obtained. The wavenumber signal itself is corrected in claims 1 and 10. Specifically, claim 1 states “correcting said wave number signal with the use of a calibration line,” and claim 10 states “correct said wavenumber signal with the use of one or more calibration line(s).”

Thus, for at least the foregoing reasons, independent claims 1 and 10 are not anticipated by Robinson, and are not obvious in view of the prior art.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as independent claims 1 and 10 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon (claims 2-9, and 11-15 respectively) are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Thus, dependent claims 1-9 and 11-15 are not anticipated by Robinson, and are not obvious in view of the prior art.

IV. Claim Rejections Under 35 U.S.C. § 102 (Bergman)

Claims 10-12 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent No. 6,424,849 (Berman et al).

Independent claim 10 has been amended by inserting elements regarding a “first calibration line” and a “second calibration line having the same inclination as said first calibration line.”

The Applicant’s respectfully submit that anticipation under 35 U.S.C. § 102(b) requires that each and every element be found in the prior art.

Although Berman does disclose a single calibration curve at Figure 6 and at column 10, lines 43 to 48, Bergman does not disclose a second calibration line having the same inclination as said first calibration line.

Thus, for at least these reasons, independent claim 10 is not anticipated by Bergman, and is not obvious in view of the prior art.

As stated above, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims. Accordingly, as independent 10 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon (claims 11-15) are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Thus, dependent claims 11-15 are not anticipated by Bergman, and are not obvious in view of the prior art.

V. Allowable Subject Matter

Claims 13 and 15 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim

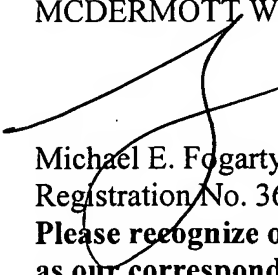
and any intervening claims. The Applicants wish to thank the Examiner for the indication of allowable subject matter in claims 13 and 15.

VI. Conclusion

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,
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